

REMARKS

The claims have been amended to clarify the patentable invention over the prior art references of record. It is noted with appreciation that claims 8 and 10-15 were objected to but were acknowledged to contain allowable subject matter. Claims 8-15 have been made independent of claim 1 and are now believed allowable. The typo in claim 9 has also been eliminated. A check for the additional independent claims and for a three (3) month extension of time is also enclosed.

In the Office Action, claims 1-7 and 9 were rejected as being anticipated by the Price reference. This rejection is respectfully traversed as to the now amended claims. The examiner contends that Price discloses a resilient stop 78 to alter an amplification ratio. However, a close reading of the Price reference shows that there simply is no disclosure that the abutment plate 78 for the return spring 76 works as a stop for the working piston Cb. In fact, the reference teaches away from any such teaching because it shows that the reaction pin 98 is sized to provide a predetermined clearance and acts as a stop -See column 4 lines 50-56. There is simply no disclosure that the working piston Cb would ever reach the base plate 78. The loose construction of the base plate 78 on the output piston Db also prevents the plate to function as a stop. Please note the gap between the spring abutment plate 78 and the output member Db on the right hand side of the plate 78. The improper mounting of the plate 78 and the teaching of the alternate stop

via piston 98 teaches away from any disclosure that plate 78 functions as a resilient stop. The stop that exists (98) also provides no disclosure that the fluid pressure servomotor would have an amplification ratio that could be altered somehow during operation of the fluid pressure servomotor. As such, the rejection as being anticipated is hereby traversed and should be withdrawn as to the claims as amended.

In the Office Action, claims 1, 2, 5 and 9 have been rejected as being obvious over the Burgdorf et al and Tsubouchi references. This rejection is also respectfully traversed as to the amended claims. The examiner recognizes that Burgdorf does not have a stop on the output member 14. However, the Burgdorf construction has a stop on element 9 in the form of a shoulder that abuts an inner shoulder in control housing 5. As such, no further stop is needed.

The examiner than states that Tsubocuchi has a stop 43 and since both "Burgdorf et al and Tsubouchi are both vacuum servo brakes with output members, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the output member of Burgdorf et al. base on the teachings of Tsubouchi to have a stop . . ."

The fact that both references are in the same field of art is not an adequate reason for combining the two references. One of ordinary skill in the art would have no basis for combining the teachings of Burgdorf with Tsubouchi in order to attempt to replicate Applicant's invention,

because there is no suggestion or motivation in the art to do so. It is well settled patent law that a sustainable obviousness rejection requires "some teaching, suggestion, or motivation to combine the references," as summarized by *In re Rouffet*, 149 F.3d 1350, 1355-56, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). See also *Robotic Vision Systems, Ind. v. View Engineering, Inc.*, 51 USPQ2d 1948 (Fed. Cir. 1999). The initial burden to point out the suggestion in the prior art for the desirability of doing what the inventor has done, is on the Examiner. MPEP § 706.02(j) More specifically, the Examiner must set forth the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention. *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000).

The mere fact that references in the same field can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Here, the Office Action lacks a proper *prima facie* showing of obviousness since the Office Action does not provide any teaching, suggestion, or motivation for combining the cited references, other than the conclusory statement that "Since . . . both are vacuum servo brakes with output members, it would have been obvious. . . ." The Office Action neither

sets forth any specific proposed suggestions as to why Burgdorf should have its existing stop modified in view of Tsubouchi to arrive at the claimed subject matter, nor any principle or specific understanding within the level of ordinary skill in the art that would have motivated a skilled artisan to combine the references.

Applicants respectfully submit that the Office Action's lack of an indication anywhere in the record of a finding in the cited references of a suggestion for the desirability of the proposed combination, militates against an obviousness rejection of Applicant's invention as claimed.

In view of a lack of suggestion from the Office Action and from the cited references, a person of ordinary skill in the art would not seek to modify or combine these references cited in the Office Action to produce the results that Applicant's invention teaches. It is only through Applicant's own teachings and disclosure that one of ordinary skill in the art would appreciate the need for a dual rate vacuum servo brake valve provided by a resilient stop. In other words, but for Applicant's disclosure, there is no teaching, suggestion, or motivation whatsoever to combine the Burgdorf reference with the Tsubouchi reference in any way in order to obviate Applicant's invention. Accordingly, Applicant respectfully asserts that the Office Action is an example of hindsight reconstruction in an attempt to obviate Applicant's invention after having the benefit of reading Applicant's disclosure.

One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the cited references to deprecate the claimed invention. See *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). The teachings or suggestions to make the claimed combination or modification and the reasonable expectation of success must both be found in the prior art and not based on Applicant's disclosure. See *In re Vaeck*, 20 USPQ2d, 947 F.2d 488, (Fed. Cir. 1991).

Assuming *arguendo* that the combination is made, it is traversed that the flange 43 in the Tsubouchi reference is resilient. A careful reading of refereed column 2, lines 42-68 provides that the output rod is maintained in an axially aligned position when the gap is eliminated between the annular flange with the end surface of hub. However no such relative axial movement is disclosed once the gap is eliminated. There is no resilient member to allow such axial movement to produce the second amplification ratio. There is simply no disclosure anywhere that the flange 48 is resilient in the Tsubouchi reference nor any reason for it to be resilient.

Furthermore, neither Burgdorf nor the Tsubouchi references disclose a volume take up means into which the reaction member 29 may be displaced. As such, even if the traversed combination is made, it does not disclose nor render obvious the limitations as set forth in claim 1 as amended.

Claims 16, 17 and 18 have been rejected as being

obvious over the combination of the above three cited references. This rejection is respectfully traversed as to the claims as amended. The addition of the Price reference does not alleviate the deficiencies of the combination of the Burgdorf and Tsubouchi references. As such, because claims 16-18 are dependent on claim 1 the same arguments for the allowance of claim 1 apply and these claims should be allowed.

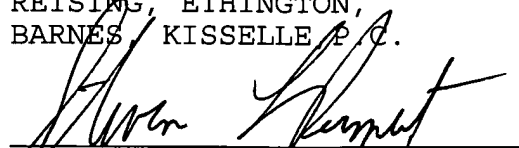
As such, it is now believed that the case is in condition for allowance and early notification of such allowance is earnestly solicited.

Applicant hereby requests a three month extension of time. Enclosed please find Check No. 8849 in the amount of \$1,620.00 for the three (3) additional independent claims and the three (3) month extension of time.

If it is determined that any additional fees are due with this submission, the Commissioner is hereby authorized and respectfully requested to charge such fee to our deposit account No. 50-0852.

Respectfully submitted,

REISING, ETHINGTON,  
BARNES, KISSELLE P.C.

  
Steven L. Permut  
Reg. No. 28,388  
P.O. Box 4390  
Troy, Michigan 48099  
(248) 689-3500

Date: January 19, 2006